Remarks

In the Office action, claims 1-11 were rejected as being unpatentable over a number of patents.

As a preliminary matter, in light of applicant's claim for priority under 35 U.S.C. §119(a)-(d), applicants maintain that the executed Declaration and Power of Attorney filed with the above identified application properly claims priority benefits under 35 U.S.C. §119 in light of Korean Patent Application Serial No. 10-2002-0061209 dated October 8, 2002. Applicants further note that the listed date of "8/10/2002" on the executed Declaration and Power of Attorney use the date format of "Day/Month/Year Filed," thereby indicating that the priority date reflected on the Declaration is October 8, 2002. As such, the above identified United States application filing date of September 19, 2003, is within the requisite twelve months of the Korean Application priority date of October 8, 2002 and, therefore, the priority claim is proper. Applicants respectfully request an indication that the priority claim is proper.

By way of the foregoing amendment claims 1, 7 and 8 and have been amended, and claim 9 has been cancelled without prejudice. Accordingly, claims 1-8, 10 and 11 are pending and at issue in the above identified patent application. Of the claims at issue, claims 1 and 7 are independent. In view of the foregoing amendments and the following remarks, reconsideration of the application is respectfully requested.

The Rejections Under 35 U.S.C. § 103

Claim 1 was rejected as being unpatentable over U.S. Patent No. 6,029,045 ("Picco") in view of U.S. Patent Application No. 2003/0226141 ("Krasnow"). Claim 7 was rejected as being unpatentable over Picco in view of U.S. Patent Application No. 2004/0133909 ("Ma"). Applicants respectfully submit that claims 1 and 7, and claims dependent therefrom, are allowable over these patents, and patent applications, for the reasons set forth below.

Claim 1

Independent claim 1 recites, *inter alia*, a method of displaying an advertisement using metadata comprising analyzing and filtering first metadata associated with an advertisement based on the user's preference and storing the advertisement selectively corresponding to the

user's preference on the local storage, displaying a television program, the television program comprising second metadata, interpreting the second metadata of the displayed television program, matching the second metadata of the displayed television program with the first metadata associated with the advertisement, and displaying the advertisement in a banner form *in response to* the matching. As discussed below, it is respectfully submitted that neither Picco nor Krasnow discloses displaying a television program comprising second metadata, much less matching the second metadata with the first metadata and displaying the advertisement in a banner form *in response to* the matching. As a result, any combination of Picco and Krasnow necessarily fails to disclose displaying a television program comprising metadata, and further fails to disclose matching the second metadata with the first metadata and displaying the advertisement in a banner in response to the matching.

It is well established that the prior art must teach or suggest each of the claim elements and must additionally provide a suggestion of, or an incentive for, the claimed combination of elements to establish a *prima facie* case of obviousness. See *In re Oetiker*, 24 USPQ. 2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 USPQ. 972, 973 (Bd. Pat. App. 1985); *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143.

While Picco describes a system for communicating a programming data stream to a set-top box and a data stream containing pieces of local content data that are going to be inserted into a local content space in the programming data stream, Picco does not disclose displaying a television program comprising second metadata, much less matching the second metadata of the displayed television program with the first metadata and displaying the advertisement in a banner form in response to the matching. Instead, Picco downloads local content (commercials) to a set-top box that includes an associated content profile. *See* 7:55-56. Unlike television programs comprising second metadata, Picco's associated content profile is a control signal sent from a scheduler 148 (in an uplink 102) which may include information regarding an interest of the household. A data transmission facility (uplink) assembles and delivers the local content (including the content profile) to the set-top box for insertion into live data streams at a later time. *See* 3:1-9. As such, the control signals determine at which time and what local content will be displayed on a user's set top box *prior to* such local content being transmitted to the user's set top box. Such temporal delay is further evidenced by Picco's downloading techniques from the uplink that slowly trickle the

local content data to the set-top box and download the local content over the channels at some predetermined time when the set-top box is probably not in use (i.e., 3 AM). *See* 3:19-23. Unlike television programs comprising second metadata, any local content Picco displays is not *responsive to* a television program being viewed by a user. Consequently, Picco does not teach or disclose displaying a television program, the television program comprising second metadata, matching the second metadata of the displayed television program with the first metadata associated with the advertisement, and displaying the advertisement in a banner form in response to the matching.

Furthermore, even if Picco describes a television program comprising second metadata, an assumption with which the applicants do not agree, rather than matching the second metadata with the first metadata and displaying the advertisement in response to the matching, Picco assembles local content *prior to*, and independent of, a television program viewed by the user. Picco employs statistical parameters, influences from outside companies, set-top box control signals, and other various information to determine what local content will be first stored to a terminal and then inserted to a live feed. *See generally* 7:23 *through* 8:11 *and* Figure 4. Unlike the claimed subject matter, Picco multiplexes (combiner 140) the live feeds with control signals and local content at a remotely located uplink 102. Picco then sends the combined local content and live feed to the set-top box, and such control signals determine what local content is displayed independent of what the user is currently viewing at the set top box. As mentioned earlier, such downloading techniques may occur during times when a user is not likely using the set-top box. As such, Picco necessarily fails any teaching of matching the second metadata with the first metadata, and displaying the advertisement in a banner form *in response to* the matching.

Although Picco's set top box components include a CPU 188 and disk 186, rather than match the second metadata of the displayed television program with the first metadata associated with the advertisement and displaying the advertisement in a banner form in response to the matching, as recited by amended independent claim 1, these components operate to store the local content and control signals sent by the uplink 102. The pieces of local content actually inserted into a programming data stream, however, are based on the uploaded control data. *See* 10:58-66. As discussed earlier, Picco generates such control data at the uplink and is not responsive to content the viewer is currently watching. Consequently,

Picco fails to disclose a method of displaying an advertisement using metadata comprising analyzing and filtering first metadata associated with an advertisement based on the user's preference and storing the advertisement selectively corresponding to the user's preference on the local storage, displaying a television program, the television program comprising second metadata, interpreting the second metadata of the displayed television program, matching the second metadata of the displayed television program with the first metadata associated with the advertisement, and displaying the advertisement in a banner form *in response to* the matching.

While Krasnow discloses advertisements in a banner and advertisements including metadata, Krasnow fails to disclose displaying a television program comprising second metadata, matching the second metadata of the displayed television program with the first metadata, and displaying the advertisement in a banner form in response to the matching. Instead, Krasnow merely describes a system, device and method for maintaining advertisements that a user has already seen, and allowing users to view those advertisements again. Krasnow's system 100 includes stored content, such as movies, television programs, and commercials. A content distribution system 106 distributes such content to client devices 108 (also referred-to as set top boxes). *See generally ¶'s 0020, 0024 and 0025.* The system 100 also includes stored on-demand content 134 to stream movies and other content to a corresponding client device 108. The client devices 108 receive all content, including advertisements. Krasnow further describes that a network operator can communicate metadata about advertisements that will be broadcast directly to the advertisement data store 302. The data store 302 stores displayed advertisements so that a viewer can, via an advertisement component 338 in the client device 108, select an advertisement to categorize, store, delete, and later find advertisements previously seen. *See generally ¶'s 0047-0050 and 0066.* Consequently, and similarly to Picco, Krasnow does not disclose matching the second metadata of the displayed television program with the first metadata associated with the advertisement, and displaying the advertisement in a banner form in response to the matching.

As neither Picco nor Krasnow disclose displaying a television program comprising second metadata, matching the second metadata of the displayed television program with the first metadata, and displaying the advertisement in a banner form in response to the matching,

as recited by amended claim 1, it follows that neither Picco nor Krasnow, alone or in combination, can render claim 1 as obvious. Dependent claims 2-6 depend from independent claim 1 and are allowable for at least the reasons discussed above in association with claim 1. Therefore, applicants respectfully request allowance of claims 1-6.

Claim 7

Independent claim 7 recites, *inter alia,* an apparatus for providing a selective advertisement display service using metadata comprising a digital television display, an advertisement including first metadata, and a matching engine operatively coupled to the digital television display displaying a television program including second metadata, the matching engine selecting the advertisement as a result of matching first metadata of the advertisement with the second metadata of the displayed television program. Neither Picco nor Ma, alone or in combination, discloses an apparatus for providing a selective advertisement display service using metadata comprising a digital television display, an advertisement including first metadata, and a matching engine operatively coupled to the digital television display displaying a television program including second metadata, the matching engine selecting the advertisement as a result of matching first metadata of the advertisement with the second metadata of the displayed television program. As a result, any combination of Picco and Ma fails to disclose the subject matter recited by claim 7.

Similar to the discussion in association with claim 1 above, Picco does not disclose metadata of a television program, much less a matching engine selecting the advertisement as a result of matching metadata of a television program with metadata associated with the advertisement. Similarly, despite Ma discussing an XML parser and metadata, the metadata further describing programs, Ma fails to disclose using such metadata as a basis for selecting an advertisement as a result of matching first metadata of the advertisement with the second metadata of the displayed television program. Instead, Ma describes a system and method for detecting skipping of advertising content by a user and redelivering the skipped advertising content to the user in accordance with user preferences.

Ma further describes a source of media content, such as a set-top box 10 providing various media information (television programs, electronic programming guides, and

advertising content) to a user, and an advertisement delivery system 22. *See ¶0022, lines 1-9 and Figure 1.* Skipped advertisements are detected by a confirmation component 120 and, in some embodiments, parsed by an XML parser 128 to parse advertisement data (metadata) prior to storage in an ad buffer 34. *See ¶0023, lines 6-15 and ¶0033, lines 10-19.* If a viewer does not view the latest advertisement, or skips an advertisement too many times, the advertisement is redelivered to the viewer. Therefore, despite Ma discussing metadata and an XML parser, Ma fails to disclose or suggest an apparatus for providing a selective advertisement display service using metadata comprising a digital television display, an advertisement including first metadata, and a matching engine operatively coupled to the digital television display displaying a television program including second metadata, the matching engine selecting the advertisement as a result of matching first metadata of the advertisement with the second metadata of the displayed television program.

As neither Picco nor Ma disclose an apparatus for providing a selective advertisement display service using metadata comprising a digital television display, an advertisement including first metadata, and a matching engine operatively coupled to the digital television display displaying a television program including second metadata, the matching engine selecting the advertisement as a result of matching first metadata of the advertisement with the second metadata of the displayed television program, as recited by amended claim 7, it follows that neither Picco nor Ma, alone or in combination, can render claim 7 as obvious. Dependent claims 8, 10 and 11 depend from independent claim 7 and are allowable for at least the reasons discussed above in association with claim 7. Therefore, applicants respectfully request allowance of claims 7, 8, 10 and 11.
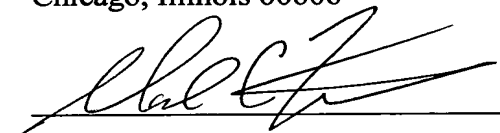
Conclusion

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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